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PATENT
Attorney Docket No. 7378/71304

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

KINOSHITA et al.

Application No.: 09/395,805

Art Unit: 1774

Filed: September 14, 1999

Examiner: B. Shewareged

For: HEAT-SENSITIVE STENCIL
SHEET

September 22, 2003

**RULE 133 STATEMENT
AND REMARKS AS A
SUPPLEMENT TO THE JUNE 24, 2003
RESPONSE TO REQUIREMENT FOR RESTRICTION**

Commissioner for Patents
U.S. Patent and Trademark Office
2011 South Clark Place
Customer Window, Mail Stop **Non-Fee Amendment**
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Dear Sir:

Applicants respectfully submit this Rule 133 Statement as a supplement to their June 24, 2003 Response to the June 4, 2003 Requirement for Restriction and the Examiner's September 9, 2003 paper.

Applicants' counsel telephoned the Examiner on September 17, 2003 to discuss the Requirement for Restriction and arranged for follow-up in the afternoon of September 18, 2003. The Examiner's courtesy in taking the telephone call and endeavoring to set up follow-up is acknowledged with appreciation. The storm, Isabel, intervened and the PTO was reportedly closed on September 18, 2003.

The following points are those that the undersigned would have been raised with the Examiner for further consideration in the telephone interview scheduled for September 18, 2003.

Applicants respectfully submit the Requirement for Restriction appeared misplaced and they respectfully suggest that it should be withdrawn.

First, it is respectfully submitted that the Requirement for Restriction mistakenly requested an election between claims 1 and 4-10 versus claim 11. According to the Examiner, claim 1 and claims 4-10 relate to a two-layer stencil sheet, and claim 11 relates to a three-layer structure. Requirement for Restriction, bottom of page 2 (claim 11 is to a "three-layered heat sensitive stencil sheet"). Claim 11 depends from claim 1 and actually claims "wherein a release agent is provided on a surface of said thermoplastic film which is not laminated to said substrate." Claim 11 does not explicitly recite a third layer or a layer of release agent.

Second, the written Requirement for Restriction does not recite a factual basis for asserting addition of a release agent to a surface as in claim 11 is both an independent and distinct invention - see the statute, 35 U.S.C. 121.

Third, Applicants request reconsideration of what appears to be a rote reliance on claim 12 being newly presented, and thus *de facto* not elected. The Requirement for Restrictions asserted "t]he process for using the product as claimed can be practiced with another materially different product." The process claimed is directed to the product recited in the claims and it is not seen that any basis exists to ignore actual claim language in order to impose a restriction requirement. It is suggested that the *de facto* non-election of claim 12 be reconsidered and withdrawn.

Fourth, Applicants respectfully submit that MPEP 803 provides constructive guidance, “[t]he Examiner must examine “the entire application on the merits, even though it includes claims to independent or distinct inventions” where, as here, “the search and examination of an entire application can be made without serious burden.” Applicants point out that their priority document was granted as a patent on March 14, 2003. As presently understood, the art of record therein is already of record before the present Examiner.

The Examiner was able to telephone the undersigned on Monday, September 22, 2003. The Examiner’s courtesy in telephoning the undersigned is acknowledged with appreciation. The items mentioned above under “first” and “second” were raised with the Examiner. It was pointed out that claim 11 does not recite a layer and therefore a legitimate, factually grounded basis for the requirement for restriction is lacking. This application has been unduly delayed by the PTO’s mistaken reading of claims and that delay should lead to patent term restoration under the AIPA.

A petition for an extension of time is **NOT** necessary. However, to the extent that such petition is deemed necessary, for a sufficient extension of time to render the present submission timely, please charge Deposit Account No. 06-1135, regarding our order number 7378/71304, for the appropriate petition fee.

Accordingly, Applicants requested a favorable action, *i.e.*, allowance, as to all claims, but contingently elect claims 1 and 4-10. Applicants earnestly but respectfully suggest that claims 11 and 12 should be kept in this application, *i.e.*, rejoined.

Respectfully submitted,

FITCH, EVEN, TABIN & FLANNERY

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In re Appln. of KINOSHITA et al.
Application No. 09/395,805

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